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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/697,212	10/30/2003	Silena Gaggini	71184	2207

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MCGLEW & TUTTLE, PC
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SCARBOROUGH, NY 10510-0827

EXAMINER

WATKINS III, WILLIAM P

ART UNIT PAPER NUMBER

1772

DATE MAILED: 11/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/697,212	GAGGINI, SILENA	
	Examiner	Art Unit	
	William P. Watkins III	1772	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 August 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☒ Claim(s) 16 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 10, 12, and 14 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

It is not clear where the limitation that the "transparent resin reflects light readily" is supported in the original specification. Being transparent is normally associated with passing light, not reflecting it.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sharif (U.S. 3,420,925).

Sharif teaches in Figure 2 an epoxy resin matrix with glass inserts where the surface of the epoxy is depressed below the level of the inserts and there is a smooth transition in the outer surface of the article between the surface of the insert and the surface of the epoxy. The inserts maybe marble and the epoxy matrix material maybe clear (col. 4, lines 40-55). The instant invention claims stone inserts in a transparent resin matrix with the level of the matrix depressed below the level of the inserts. It would have been obvious to one of ordinary skill in the art to make the matrix of Figure 2 of Sharif clear and use marble as inserts in order to fully practice the invention of the reference because of the teachings of Sharif. As the resin of Sharif is transparent and there are no disclosed abrasive steps, it is also taken as being reflective as instantly claimed.

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-10, 12-15 are rejected under 35 U.S.C. 102(b) as being anticipated by JP-A 07-100816 (see the JPO machine translation).

Sections 0004 and 0005, and Figures 1 and 2 describe a resin matrix with a coloring agent that has stones embedded in the matrix, where the matrix is polished to provide a flat surface for the stones with a good appearance and then some of the resin between the stones is removed by water jet to create depressions that have an anti-slip function when the resin matrix and is used as a flooring material.

6. Claim 16 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The limitation of a useful surface defined by the surface of the resin and the highest point of the coplanar inserts, being graduated and free from any steps or irregularities between the edges of the inserts and said coplanar leveled surface in combination with the other limitations of the claim

define over the cited art. In particular, JP-A '816 shows a discontinuity in the surface formed by the planar inserts and the resin matrix at the edge of the inserts. Sharif does not show a discontinuity, but also does not show a coplanar insert surface as required by claim 16.

7. Applicant's arguments filed 20 August 2004 have been fully considered but they are not persuasive.

Applicant argues that the water jet resin removal of JP-A '816 results in a step discontinuity in the outer surface of the article at the edge of the insert. While the examiner accepts this interpretation of the reference, the specific claim language of claims 1, 4, 8, 13 and 15 does not define over the reference. Claims 1 and 8 call for the edge of the resin surface to meet the edge of the inserts. The vertical side surface of the inserts is taken as being an edge and meeting this limitation. Regarding claim 4, it is not clear what surface shape the brushing produces. Regarding claims 13 and 15 is not clear that a smooth vertical side surface that intersects the resin surface should be considered as having an irregularity. It is also not clear that the water jet process produces any change in reflection that is different from that

caused by a brushing process. JP-A '816 has not been applied to claim 11, but a new ground of rejection is given regarding this claim above.

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to William

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P. Watkins III whose telephone number is 571-272-1503. The examiner works an increased flex time schedule, but can normally be reached Monday through Friday, 11:30 A.M. through 8:00 P.M. Eastern Time. The examiner returns all calls within one business day unless an extended absence is noted on his voice mail greeting.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 571-272-1498. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



WW/ww

November 14, 2004

WILLIAM P. WATKINS III
PRIMARY EXAMINER